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Appl. No. : 10/691,695
Office Action Dated : 09/20/2006
Response Mailed / Faxed : 03/19/2007

RESPONSE / REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested. The status of the claims are as follows:

Claims 1-3, 5, 13, 14, 16, 27, 39 and 40 remain under examination and are "currently amended" for presentation in this response;

Claims 4, 8, 15 and 17 have been canceled without prejudice; and

Claims 6-7, 9-12, 18-26, 28-38 and 41 have been withdrawn from consideration at this time.

The applicant requests that the drawings and the new matter identified by the examiner be disregarded, and that the original drawings submitted with the original application be identified as the drawings for purpose of examination. In light of this request, the applicant is resubmitting the original drawings Fig. 1 through Fig. 12 (Sheet 1 through Sheet 6) as a separate drawing attachment to this response.

The claims have been amended in a manner that overcomes the rejection of Claims 1, 2, 3, 5, 8, 13, 15, 16, 27, 39 and 40 under 35 U.S.C. § 112, 2nd Paragraph. The phrases "one interchangeable syringe guide", "interchangeable with each other", "said interchangeable syringe guides" and "may fit" have each been deleted from the respective claims previously identified by the Examiner. The specific amendments to the claims are discussed in greater detail below. The applicant respectfully requests that the Examiner withdraw this rejection.

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In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(b), a primary tenet is that the reference must teach every element of the claim(s). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). And, as stated by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every claim element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Claim 1 (apparatus) and Claim 27 (method), have been amended and are considered patentably distinguishable as unanticipated and nonobvious when compared to the prior art cited by the Examiner.

Claim 1 and Claim 27 have been amended to include the following elements, as disclosed in the original specification and drawing(s), finding support in the specification as noted:

a housing (16) (Fig. 1 and lines 193-194);

the housing having a vial compartment (in which vial (14) is placed - Fig. 1 and lines 193-194) and a guide compartment (specifically reference character (18) in which syringe (12) is placed - Fig. 1 and lines 197-202), with the vial compartment and the guide compartment mutually adjacent to one another (see Fig.

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1 for the mutually adjacent alignment depicted therein);

articulated door (24) mounted to the housing (16) (Fig. 1 - door (24) includes at least one hinge for mounting the door to the housing and providing articulated movement of the door between an opened and a closed position, respectively); and

the syringe guide (18) having an aperture (rests beneath retainers (20) as depicted in Fig. 1).

Claim 5 has been amended to describe that guide as comprising transparent material (lines 197-200).

Claim 14 has been amended to describe the door having a magnifier (lines 199-201).

As amended, Claim 1 is patentably distinguishable over the prior art cited. Claim 1 recites (quoting for convenience):

Claim 1. An apparatus for filling a syringe from a vial comprising:
a housing having a vial compartment and a guide compartment mutually adjacent and concentric about an axial length;
an articulated door mounted to the housing;
the door selectively movable between a closed position and an open position, wherein the door mechanically communicates with the housing and encloses the housing in a closed position, and wherein the door provides access to the compartments in an open position;
a syringe guide removable from the guide compartment; and
the guide comprising an aperture traversing the axial length of the guide accommodating insertion of the syringe therethrough for guided communication with the vial.

The claim recites an apparatus consistent with the elected species depicted in Fig. 1 of the original drawings, the apparatus comprising a housing having a vial compartment and a guide compartment mutually adjacent and mutually concentric about an axial length. An articulated door is mounted to the housing, and

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is movable between closed and open positions. The apparatus further includes a syringe guide removable from the guide compartment. The guide also comprises an aperture that traverses the length of the guide for insertion of the syringe therethrough. Neither Tetreault nor Larrabee, separately or in combination, disclose a device comprising the elements and the arrangement of the elements as disclosed in Claim 1. Tetreault discloses an alignment guide having an exterior housing and an internal tube for receiving a syringe. Neither the exterior housing nor the internal tube are described as providing mutually adjacent and mutually concentric compartments for housing a vial and a syringe guide, respectively, about an axial length, and fails to disclose an articulated door that opens and closes relative to the housing. Larrabee discloses a device having an inner sleeve, an intermediate sleeve and an outer sleeve coupled with one another to guide a syringe into communication with a vial. Neither the inner sleeve, the intermediate sleeve, nor the outer sleeve, separately or in combination, are described as providing mutually adjacent and mutually concentric compartments for housing a vial and a syringe guide, respectively, about an axial length, and fails to disclose an articulated door that opens and closes relative to the housing. As such, neither Tetreault nor Larrabee, separately or in combination, disclose each of the elements as arranged in Claim 1 as required, thus Claim 1, as amended, is patentably distinguishable over Tetreault and / or Larrabee. Likewise, the remaining dependent claims (Claims 2, 3, 5, 13, 14, 16, 39 and 40, respectively) are also patentably distinguishable over Tetreault and / or Larrabee as being dependent from a patentably distinguishable and allowable independent claim (Claim 1). Withdrawal of this rejection is respectfully requested, and an expedited notice of allowance for Claims 1, 2, 3, 5, 13, 14, 16, 39 and 40 is respectfully requested.

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As amended, Claim 27 is patentably distinguishable over the prior art cited. Claim 27 recites (quoting for convenience):

27. A method for filling a syringe from a vial comprising:
- a) using an apparatus having
 - a housing having a vial compartment and a guide compartment mutually adjacent and concentric about an axial length;
 - an articulated door mounted to the housing;
 - a syringe guide removable from the guide compartment; and
 - the guide comprising an aperture traversing the axial length of the guide accommodating insertion of the syringe therethrough for guided communication with the vial.
 - b) placing the vial in the vial compartment,
 - c) selecting an appropriately sized syringe for the aperture and inserting the syringe in the aperture,
 - d) inserting the syringe through the aperture into the vial, and
 - e) filling the syringe with fluid from the vial.

The claim recites an method for filling a syringe from a vial consistent with the elected species depicted in Fig. 1 of the original drawings, the method for filling a syringe comprising an apparatus comprising a housing having a vial compartment and a guide compartment mutually adjacent and mutually concentric about an axial length. An articulated door is mounted to the housing, and is movable between closed and open positions. The apparatus further includes a syringe guide removable from the guide compartment. The guide also comprises an aperture that traverses the length of the guide for insertion of the syringe therethrough. As noted previously in regard to Claim 1, neither Tetreault nor Larrabee, separately or in combination, disclose a guide means comprising a plurality of apertures of variously sized diameters from which one is selected for insertion of the syringe to the vial, for the particular reasons set forth above and incorporated by reference herein as if fully rewritten. As such, neither Tetreault nor Larrabee, separately

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or in combination, disclose each of the elements of Claim 27 as required, thus Claim 27, as amended, is patentably distinguishable over Tetreault and /or Larrabee. Withdrawal of this rejection is respectfully requested, and a notice of allowance for Claim 27 is respectfully requested.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j).

As stated above, neither Tetreault nor Larrabee independently disclose every element of Claim 1 and Claim 27, and thus fail to anticipate the claims. The combination of the Tetreault and Larrabee references fails to disclose every element of the respective claims, therefore, the combination of references fails to teach, suggest, disclose or claim every element of the respective claims as required. Thus, Claim 1 and Claim 27, and any claims depending therefrom, are patentably distinguishable over the combination of Tetreault and Larrabee. Withdrawal of this rejection is respectfully requested, and an expedited notice of allowance for Claims 1, 2, 3, 5, 13, 14, 16, 27, 39 and 40 is respectfully requested.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative

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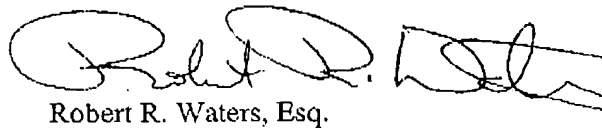
teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. There is nothing in the prior art that would suggest the desirability or obviousness of making a device as claimed in Claim 1 or the method as claimed in Claim 27. Uniroyal, Inc. v. Rudkii-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,



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